UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,949	01/17/2006	Diego Anza Hormigo	P1942US	4094

				EXAMINER

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EXAMINER
HUYNH, NAM TRUNG

ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/564,949	ANZA HORMIGO ET AL.
	Examiner	Art Unit
	NAM HUYNH	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 September 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 and 3-12</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 and 3-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20090921

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/11/09

has been entered.

Response to Amendment

This office action is in response to amendment filed on 9/11/09. Of the

previously presented claims 1, 2, and 3-12; claims 1 and 10 have been amended.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 1 and 3-12 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Regarding claim 1, the amended subject matter recites: "...and the first step is

activated during an activation of the second step..." The subject matter of this limitation

implies that the first and second step are activated or performed at the same time.

Based on the definition of these two steps, they can not be performed concurrently

because the first step involves "sending a first signal" and the second step involves

"determining a present or not present state based on the reaction of the mobile

communication network to said first signal". The second step of "determining" requires

the first step of "sending a first signal", thus the two steps can not logically occur at the

same time as the amended claim language implies. For examination purposes with

respect to prior art, the amended claim language will be interpreted as " and positioning

said time delay that is a function of the present or not present state determined in the

second step", which is the Examiner's best interpretation.

Regarding claims 3-9, the limitations are rejected based on their dependence on

claim 1.

Regarding claim 10, the limitations are rejected as applied to claim 1.

Regarding claims 11 and 12, the limitations are rejected based on their

dependence on claim 10.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
        obviousness or nonobviousness.

6.   Claims 1, 4, and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of Kirkpatrick et

al. (US 7,373,144) (hereinafter Kirkpatrick).

        Regarding claim 1, Ouzounidis teaches a method for informing an application

server (presence server) whether or not a mobile subscriber is present on a mobile

telecommunication network, the method comprising:

        a first step for sending a first signal distinctive of the mobile subscriber to the

mobile telecommunication network (SMS-C), intended for the mobile subscriber (an

SMS message is sent from the presence to the SMS-C);

        a second step for determining a present or not present binary state according to

a reaction of the mobile telecommunication network to said first signal (SMS-C

determines if message is delivered to the mobile telephone); and

        a third step for communicating to the application server the state determined in

the second step (SMS-C sends an acknowledgement back to the presence server of

where the mobile telephone is available);

        wherein:

a first transition enabled by a reaction of the mobile telecommunication network

indicating that the message is delivered (SMS-C acknowledges to the presence server

that the mobile telephone is available), respectively a second transition enabled by an

expiry of a time delay (specified time limit) without reaction from the mobile

telecommunication network, activates the second step that determines the present,

respectively not present state of the mobile subscriber (the SMS-C determines that the

mobile telephone is unavailable if the message is not delivered within the specified time

limit) (column 7, lines 5-30).

However, Ouzounidis does not explicitly teach positioning said time delay that is

a function of the present or not present state determined in the second step. Kirkpatrick

discloses a system and method for automatically providing user status in a messaging

service (title). Kirkpatrick teaches positioning a time delay (T2) that is a function of the

present or not present state (expiry of T1 designates a "not present" state of the

wireless device) (column 5, lines 10-49). Therefore it would have been obvious to one

of ordinary skill in the art at the time the invention was made to modify the invention of

Ouzounidis to include an additional delay period when waiting for the message

delivered acknowledgment, as taught by Kirkpatrick, in order to use the expiry of the

first specified time limit to indicate to the originator that the recipient is out of coverage

or that the communication will be made when the recipient becomes available. This

modification allows enhances the user friendliness of the system in that the originator

will know why a communication is unsuccessful.

Regarding claim 4, Ouzounidis teaches the first step is activated during an activation of the second step by positioning a time delay that is a function of the present or not present state determined in the second step (column 7, lines 5-30).

Regarding claim 5, Ouzounidis teaches a step of a wait time activated when the second step determines the present state so as to activate the first step after expiry of the wait time (paragraph 134).

Regarding claim 6, Ouzounidis teaches said first signal consists of a telecommunication network node interrogation of the present or not present state of the mobile subscriber (SMS-C interrogates availability with SMS); and

the reaction of the mobile telecommunication network includes a response of the telecommunication network node on the present or not present state of the mobile subscriber (SMS-C responds to request of presence server with acknowledgment) (column 7, lines 5-30);

Regarding claim 7, Ouzounidis teaches said first signal consists of a positioning of a detection point on a telecommunication network node relating to any modification of the present or not present state of the mobile subscriber (SMS is used to detect availability of the mobile telephone); and

the reaction of the mobile telecommunication network includes a notification of the telecommunication network node (SMS-C) relating to each modification of the present or not present state of the mobile subscriber (SMS-C acknowledges to presence server whether the mobile telephone is available or not) (column 7, lines 5-30).

Regarding claim 8, Ouzounidis teaches an activation of the third step communicating the present state to the application server is followed by an activation of the third step communicating the not present state to the application server when the state determined in the second step passes from present to not present (the SMS-C reports to the presence server that the mobile telephone is unavailable) (column 7, lines 5-30).

Regarding claim 9, Ouzounidis teaches an activation of the third step results from a transition enabled by a request originating from the server to request the state of the mobile subscriber (message is sent from presence server to the SMS-C to determine availability) (column 7, lines 5-30).

Regarding claim 10, the limitations are rejected as applied to claim 1.

Regarding claim 11, Ouzounidis teaches the first means is arranged to send the first signal in the form of a short message intended for the mobile subscriber (SMS-C sends SMS to mobile telephone); and

the second means is arranged to determine the present state when the short message is delivered and to determine the not present state when the short message is not delivered after expiry of a preset time delay (SMS-C determines that the mobile telephone is unavailable when the message is not delivered in a specified time period) (column 7, lines 5-30).

Regarding claim 12, Ouzounidis teaches the first means is are arranged to send said first signal at regular time intervals that depend on the present or not present state

of the mobile subscriber (SMS is used to determine if the availability of the mobile

telephone) (column 7, lines 5-30).

7.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of Kirkpatrick et al.

(US 7,373,144) (hereinafter Kirkpatrick) as applied to claim 1, and further in view of

Ganor (US 2004/0219908).

The combination of Ouzounidis and Kirkpatrick teaches said first signal is a short

message sent to the mobile telecommunication network intended for the mobile

subscriber (column 7, lines 5-30), but does not explicitly teach positioning a data coding

scheme parameter in a header of the short message at a value that has the effect of

commanding the mobile receiving the message to discard the content of the message

and to deactivate a message received indication on the mobile. Ganor discloses a

method and system for detecting availability of a wireless device (title). Ganor teaches

positioning a data coding scheme parameter in a header of the short message (SMS0)

at a value that has the effect of commanding the mobile receiving the message to

discard the content of the message and to deactivate a message received indication on

the mobile (paragraphs 10-12). Therefore it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the combination of

Ouzounidis and Kirkpatrick to send a SMS with a header which is not indicated to the

user of the handset, as taught by Ganor, in order to prevent the determination of

availability to interfere with the user and so that the message can be automatically

discarded.

8.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Ouzounidis et al. (US 7,130,918) (hereinafter Ouzounidis) in view of Kirkpatrick et al.

(US 7,373,144) (hereinafter Kirkpatrick) as applied to claim 4, and further in view of

O'Neil et al. (US 7,127,232) (hereinafter O'Neil).

The combination of Ouzounidis and Kirkpatrick teaches the limitations of claim 4

and a step of a wait time activated when the second step determines the present state

(column 7, lines 5-30), but does not explicitly teach activating the first step after expiry

of the wait time. O'Neil discloses multiple access internet portal revenue sharing.

O'Neil teaches that if a phone can not be reached by a SMSC the message will be retry

transmission (column 12, lines 20-28). Therefore it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify the combination of

Ouzounidis and Kirkpatrick to retry transmission of the SMS message after the specified

time period, as taught by O'Neil, in order to continue monitoring to determine when the

mobile telephone becomes available.

Response to Arguments

9.   Applicant's arguments with respect to claims 1 and 3-12 have been considered

but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/   /Nam Huynh/
Supervisory Patent Examiner, Art Unit 2617   Examiner, Art Unit 2617